

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* FRANKLIN C. BRADSHAW  
and THOMAS L. SODERMAN

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Appeal 2006-2744  
Reissue Application 09/664,794<sup>1</sup>  
Patent 5,584,962  
Technology Center 1700

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Decided: July 19, 2007

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Before BRADLEY R. GARRIS, *Administrative Patent Judge*, FRED E. MCKELVEY, *Senior Administrative Patent Judge*, and ALLEN R. MACDONALD, *Administrative Patent Judge*.

GARRIS, *Administrative Patent Judge*.

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<sup>1</sup> This application, filed September 19, 2000, is a continuation of Application No. 09/213,876, filed December 17, 1998, and seeks reissue of U.S. Patent No. 5,584,962, which issued December 17, 1996 from Application No. 08/247,003, filed May 20, 1994.

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## DECISION ON APPEAL

### *Statement of the Case*

This is an appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 36-48 in the above identified reissue application as being unpatentable under 35 U.S.C. § 251 based on recapture. We have jurisdiction under 35 U.S.C. § 6.

We REVERSE.

Appellants invented an apparatus and a method for processing a master in conjunction with a supply of first and second feed materials. Independent claims 36 and 47 respectively define the apparatus and method as follows:

36. An apparatus for processing a master in conjunction with a supply of a first feed material and a supply of a second feed material, at least one of said feed materials carrying a layer of adhesive, said apparatus comprising:

a frame having an outer shell including (a) a lower outer shell portion having downwardly facing surfaces constructed and arranged to [be] placed on a substantially flat support surface for supporting said apparatus and (b) an upper outer shell portion movably connected to said lower shell portion for movement between an open position and a closed position relative to said lower outer shell portion by manually engaging said upper outer shell portion directly and lifting said upper outer shell portion upwardly to said open position thereof; and

a pair of cooperating pressure applying structures located within said outer shell, said cooperating structures being constructed and arranged to be positioned adjacent one another in a cooperating pressure apply relationship wherein, when the master with the first and second feed materials on opposing sides thereof and the adhesive contacting the master is positioned

between said cooperating structures, said cooperating structures apply pressure to said master and feed materials as they advance therethrough so as to bond said adhesive to said master;

an upper one of said pair of said cooperating pressure applying structures being connected with said upper outer shell portion such that (a) movement of said upper outer shell portion to said open position thereof moves the upper one of said cooperating pressure applying structures apart from a lower one of said cooperating pressure applying structures to facilitate positioning of said feed materials in between said cooperating structures and (b) movement of said upper outer shell portion to said closed position thereof positions the upper one of said cooperating structures adjacent the lower one of said cooperating pressure applying structures in said cooperating pressure applying relationship as aforesaid;

said frame providing a first mounting portion constructed to receive and mount said supply of said first feed material and a second mounting portion constructed and arranged to receive and mount said supply of said second feed material.

47. A method for using an apparatus for processing a master in conjunction with a supply of a first feed material and a supply of a second feed material, at least one of said feed materials carrying a layer of adhesive, said apparatus comprising: a frame having an outer shell including (a) a lower outer shell portion having downwardly facing surfaces constructed and arranged to be placed on a substantially flat support surface for supporting said apparatus and (b) an upper outer shell portion movably connected to said lower shell portion for movement between an open position and a closed position relative to said lower outer shell; and a pair of cooperating pressure applying structures located within said outer shell, said cooperating structures being constructed and arranged to be positioned adjacent one another in a cooperating pressure applying relationship wherein, when the master with the first and second feed materials on opposing sides thereof and the adhesive contacting the master is positioned between said cooperating structures, said cooperating structures apply pressure to said master and feed materials as they advance therethrough so as to bond said adhesive to said master; an upper one of said pair of said cooperating pressure applying structures being connected with said upper

outer shell portion such that (a) movement of said upper outer shell portion to said open position thereof moves the upper one of said cooperating pressure applying structures apart from a lower one of said cooperating pressure applying structures to facilitate positioning of said feed materials in between said cooperating structures and (b) movement of said upper outer shell portion to said closed position thereof positions the upper one of said cooperating structures adjacent the lower one of said cooperating pressure applying structures in said cooperating pressure applying relationship as aforesaid, said method comprising:

manually engaging said upper outer shell portion directly and lifting said upper outer shell portion upwardly to said open position thereof;

disposing said first and second feed materials in such a position with respect to said cooperating pressure applying structures that, when said upper outer shell portion is lowered to said closed position thereof to move said upper one of cooperating structures adjacent the lower one of said cooperating pressure apply structures [in] said cooperating pressure applying relationship thereof, said first and second feed materials will be positioned between said cooperating structures;

then lowering said upper outer shell portion to said closed position thereof to position the upper one of said cooperating structures adjacent the lower one of said cooperating pressure applying structures in said cooperating pressure applying relationship thereof with said first and second feed materials positioned therebetween; and

while said upper outer shell portion is in said closed position thereof and said cooperating structures are in said cooperating pressure applying relationship thereof with said first and second feed materials therebetween, advancing said master with the first and second feed materials on opposing sides thereof and said adhesive contacting the master between said cooperating structures such that said cooperating structures in said cooperating pressure applying relationship thereof apply pressure to said master and feed materials as they advance therethrough so as to bond said adhesive to said master.

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Claims 36-48<sup>2</sup> stand rejected under 35 U.S.C. § 251 as being unpatentable based on recapture.

The Examiner finds that the rejected claims do "not include the limitations which applicant[s] presented in Application 08/247,003 [which matured into the '962 patent for which reissue is sought] to overcome the prior art of record" (Answer, mailed Dec. 13, 2005, (hereinafter Answer) 4). Based on this finding, the Examiner concludes that Appellants are "attempting to recapture subject matter that was surrendered in application 08/247,003" (*id.*).

In support of their opposing view, the Appellants present the following argument:

The Applicants submit that the recapture rule does not bar the patentability of independent claims 36 and 47, and thus these claims and their respective dependent claims are patentable under 35 U.S.C. § 251. Specifically, neither of these independent claims impermissibly recaptures the claim scope sought during the original prosecution of the '962 patent, as each independent claim contains limitations narrowing them in material respects relative to both the claims originally sought during the prosecution of the '962 patent, and the claims ultimately issued in the '962 patent. [Br., filed Feb. 14, 2003, (hereinafter Br.) 4]

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<sup>2</sup> In addition to the bracketed informalities noted in the above reproductions of claims 36 and 47, the claim 48 phrase "said selected substrate" is informal because it lacks antecedent basis. These informalities are deserving of correction.

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### *Issues*

- (1) Are the appealed claims broader than the patent claims in aspects relating to subject matter surrendered during original prosecution of the '962 patent?
- (2) If so, do these claims nevertheless avoid the recapture rule because they are materially narrowed in other respects?

### *Findings of Fact Relevant to Issue (1)*

1. On May 20, 1994, Appellants filed the original '003 application with apparatus claims including representative independent claim 11 which is reproduced below:

11. An applicator and adhesive transfer device comprising:
  - (a) an upper frame member having opposite sides and a lower frame member having opposite sides, said upper frame member being pivotally connected to said lower frame member;
  - (b) a first nip roller rotatively mounted and extending between the sides of said upper frame member;
  - (c) a first mounting means associated with the upper frame member;
  - (d) a second nip roller rotatively mounted and extending between the sides of said lower frame member;
  - (e) a second mounting means associated with the said lower frame member; and
  - (f) actuating means for imparting rotation to at least one of said nip rollers.

2. On March 2, 1995, claim 11 and other claims were rejected over prior art which included U.S. Patent No. 4,619,728 to Brink.
3. On July 5, 1995, Appellants filed a response to this prior art rejection which included an amendment adding a pre-tensioning means limitation to claim 11 and which included an argument that this limitation rendered claim 11 patentable over the prior art including the Brink patent. Amended claim 11 is reproduced below<sup>3</sup> wherein the pre-tensioning means limitation is recited in clause (g):

Claim 11 (Amended) An applicator and adhesive transfer device comprising:

- (a) an upper frame member having opposite sides and a lower frame member having opposite sides, said upper frame member being pivotally connected to said lower frame member;
- (b) a first nip roller rotatively mounted and extending between the sides of said upper frame member;
- (c) [a] first mounting means assisted with the upper frame member;
- (d) a second-nip roller rotatively mounted and extending between the sides of said lower frame member;
- (e) [a] second mounting means associated with the said lower frame member;

[and]

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<sup>3</sup> Underlined matter was added by the amendment, and [bracketed] matter was deleted by the amendment.

(f) first and second rolls of feed stock material each having a core about which the feed stock material is wound and having support means for supporting said rolls for rotation in said respective first and second mounting means;

(g) pre-tensioning means integrally associated with said core and mounting means for selectively establishing a predetermined resistance to rotation of the rolls of feed stock material to maintain the proper application tension for the feed stock material; and

([f]h) actuating means for imparting rotation to at least one of said nip rollers.

4. On October 25, 1995, amended claim 11 and other claims were rejected over the Brink patent and other prior art.
5. On February 29, 1996, Appellants filed a response to this prior art rejection including an amendment to claim 11 which added additional limitations to the pre-tensioning means feature. A copy of twice amended claim 11 appears below<sup>4</sup>:

Claim 11 (Twice Amended) An applicator and adhesive transfer device comprising:

- (a) an upper frame member having opposite sides and a lower frame member having opposite sides, said upper frame member being pivotally connected to said lower frame member;
- (b) a first nip roller rotatively mounted and extending between the sides of said upper frame member;
- (c) first mounting means associated with the upper frame member;

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<sup>4</sup> Underlined matter was added by the amendment, and [bracketed] matter was deleted by the amendment.

- (d) a second nip roller rotatively mounted and extending between the sides of said lower frame member;
- (e) a second mounting means associated with the said lower frame member;
- (f) first and second rolls of feed [stock] material each having a generally cylindrical core about which the feed [stock] material is wound and [having support means for supporting said rolls] being supported for rotation in said respective first and second mounting means;
- (g) pre-tensioning means integrally associated with each of said cores [and mounting means] for selectively establishing a predetermined resistance to rotation of the rolls of feed [stock] material to provide the proper application tension for the feed [stock] material, said pre-tensioning means including a tensioning cap affixed to said associated core having an end plate engaging the associated core and said plate having with securement means engageable in said mounting means and further including biasing means for applying a predetermined force biasing said end plate into engagement with the associated core; and
- (h) actuating means for imparting rotation to at least one of said nip rollers.

6. On April 16, 1996, a Notice of Allowability was mailed which stated that the pending claims including twice amended claim 11 were allowed.
7. On December 17, 1996, the Appellants' '962 patent was issued with twice amended claim 11 having been renumbered as claim 10.
8. On the record of this appeal, the Appellants acknowledge that the pre-tensioning means limitations of patent claim 10 "are not present in reissue

claim 36 and were added to claim 10 of the '962 patent for purposes of securing its allowance" (Br. 6).

*Findings of Fact Relevant to Issue (2)*

9. On September 19, 2000, the subject reissue application was filed, and, on December 20, 2000, a Preliminary Amendment was filed presenting claims 36-48 to an apparatus and a method for processing a master.
10. On March 2, 2001, claims 36-48 were rejected over the above-mentioned Brink '728 patent alone and further in view of other prior art.
11. On May 14, 2001, an interview was held between the Examiner and the Appellants' representative wherein the Examiner stated that proposed claims were patentable over the prior art of record because "the prior art does not teach the concept of manually engaging the upper outer shell portion directly and lifting the upper outer shell portion directly to the open position" (Interview Summary 3). The Examiner further stated that "[t]he closest prior art reference of Brink (U.S. Patent No. 4,619,728) employs a thumb screw 21 and thus the user does not manually engage the upper outer shell portion directly in the manner claimed by the applicant[s]" (*id.*).
12. On May 16, 2001, in response to this interview, the Appellants filed amended claims 36-48 which correspond to the claims on appeal (and presumably correspond to the claims proposed in the May 14, 2001 interview).
13. Thereafter, the prior art rejections based on the Brink patent were not applied against these claims.

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### *Principles of Law*

Under the recapture rule, a patentee or reissue applicant is precluded from regaining the subject matter that had been surrendered in an effort to obtain allowance of the original claims. *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 1349, 75 USPQ2d 1545, 1556 (Fed. Cir. 2005). As explained in *North American Container*:

We apply the recapture rule as a three-step process: (1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims; (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.

*Id. Accord, Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1371, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001); *Hester Indus. v. Stein, Inc.*, 142 F.3d 1472, 1482-83, 46 USP2d 1641, 1649-50 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164-65 (Fed. Cir. 1997).

### *Analysis*

In applying the first step of the analytical process for the recapture rule, we determine that the reissue claims on appeal are broader in scope than the patent claims in that the reissue claims contain none of the pre-tensioning means limitations of the patent claims. Indeed, as noted at

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Finding 8, the Appellants acknowledge that these patent claim limitations are not present in reissue independent apparatus claim 36 (Br. 6). Additionally, no pre-tensioning limitations of any kind are present in reissue independent method claim 47.

We begin our assessment of the second recapture rule step by reviewing Findings 3-5. At Finding 3, we noted that Appellants' original '003 application claim 11 was amended on July 5, 1995 to include a pre-tensioning means limitation in clause (g) thereof. This amended claim was rejected on October 25, 1995 over prior art which included the Brink patent as observed at Finding 4. This amended claim was then further amended on February 29, 1996 to include additional pre-tensioning means limitations in a successful effort to avoid the aforementioned prior art rejections (*see* Finding 5).

These findings reveal that the initial pre-tensioning means limitation of July 5, 1995 was clearly surrendered by the Appellants because they further amended claim 11 to include additional pre-tensioning means limitations in order to avoid the prior art. By submitting these additional limitations, the Appellants inferentially admitted that the July 5, 1995 claim 11 containing the initial pre-tensioning means limitation was not patentable over the prior art.

For this reason alone, it is clear that the broader aspects of the reissue claims, which contain no pre-tensioning limitations at all, relate to subject

matter surrendered in the original prosecution as required by the second recapture rule step.<sup>5</sup> The Appellants believe that the reissue method claims on appeal cannot involve surrendered subject matter because "no method claim was ever presented during prosecution of the '962 patent" (Br. 14). However, surrender is not avoided merely by categorizing the claim 47 invention as a method rather than an apparatus. It is the scope of a claimed invention, not its categorization, which determines whether surrendered subject matter has crept into a reissue claim. Since the scope of claim 47 encompasses broader aspects with no pre-tensioning limitations at all, these claim 47 broader aspects relate to surrendered subject matter.

We begin application of the third recapture rule step by observing that both the Appellants and the Examiner agree that the reissue claims on appeal are narrower than the patent claims with respect to features other than the broader pre-tensioning aspects discussed above (Br. 6-7, 14; Answer paras. bridging 4-5 and 8-9). Specifically, the reissue claims, unlike the claims which were prosecuted and issued in the '962 patent, are limited to a frame having an outer shell including a lower outer shell portion having downwardly facing surfaces constructed and arranged to be placed on a substantially flat support surface for supporting the apparatus and an upper outer shell portion movably connected to the lower shell portion for

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<sup>5</sup> In the Examiner's more expansive view, the surrendered subject matter also includes the additional pre-tensioning means limitations submitted on February 29, 1996 in the Appellants' successful effort to avoid the prior art (Answer 8). This view is supported by the rationale expressed in the plurality opinion of *Ex parte Willibald Kraus*, 2006 W.L. 3939191 (Bd. Pat. App. & Inter. 2006). Under the circumstances of this appeal disposition, we need not express an opinion on the merits of the Examiner's view.

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movement between an open position and a closed position relative to the lower outer shell portion by "manually engaging said upper outer shell portion directly and lifting said upper outer shell portion upwardly to said open position thereof" (independent apparatus claim 36; independent method claim 47).

The Appellants consider these limitations to render the appealed claims materially narrowed relative to the claims prosecuted and issued in their patent, thereby avoiding the recapture rule (Br. 6, 14).

The Examiner also considers these limitations to materially narrow the reissue claims (Answer 8, last full sentence). Nevertheless, the Examiner believes that Appellants' reissue claims do not avoid the recapture rule because "[t]hese added limitations concerning the 'outer shell' are not related to the surrendered subject [matter] concerning the 'pre[-]tension[ing] means'" (Answer 9). In the Examiner's view, the recapture rule is not avoided because the added limitations are materially narrowing in aspects (i.e., the outer shell features) not related to the surrendered subject matter (i.e., the pre-tensioning features). As support for this view, the Examiner cites: *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 48 USPQ2d 1631 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); and *Mentor Corp. v. Colorplast*, 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993) (Answer 5, 9).

Contrary to the Examiner's belief, avoidance of the recapture rule does not require that a materially narrowing limitation of a reissue claim be related to its broader aspects surrendered in the original prosecution. This is

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clearly revealed by express language in a number of legal precedents including the *Pannu* decision cited by the Examiner.

For example, we previously explained that the Federal Circuit in *North American Container* characterized the second and third steps in applying the recapture rule as determining "whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution" and "whether the reissued claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule." 415 F.3d at 1349, 75 USQ2d at 1556 (emphases added), citing for authority *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600. The language "materially narrowed in other respects" relates for comparison back to the earlier recited "broader aspects of the reissued claims" (i.e., surrendered subject matter). Thus, by using the phrase "in other respects" to modify "materially narrowed," the court makes clear that reissue claims will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter. This plain language in *North American Container* directly contradicts the Examiner's belief that the recapture rule is not avoided if the added limitations are a materially narrowing in respects other than the broader aspects relating to surrendered subject matter.

In *Pannu*, the Federal Circuit described the second step of the recapture rule analysis as determining "whether the broader aspects of the reissued claim related to surrendered subject matter." 258 F.3d at 1371, 59 USPQ2d at 1600 (quoting *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164). With regard to the third step, the court stated: "Finally, the Court

must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule." *Id.* (emphases added), citing for authority *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. As in *North American Container*, the language "materially narrowed in other respects" relates for comparison back to the earlier recited "broader aspects of the reissued claim" (i.e., surrendered subject matter). Again, modification of "materially narrowed" with the phrase "in other respects" clarifies that reissue claims will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter. It follows that the express language of *Pannu* militates against rather than for the Examiner's view that the recapture rule is not avoided if the limitations added to a reissue claim are materially narrowing in respects other than the broader aspects relating to surrendered subject matter.

Similarly, in *Hester Indus.*, the Federal Circuit determined that "surrendered subject matter - i.e., cooking other than solely with steam and with at least two sources of steam – has crept into the reissue claims [because] [t]he asserted reissue claims are unmistakably broader in these respects." 142 F.3d at 1482, 46 USPQ2d at 1649. Immediately after making this determination, the court then stated: "Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects." *Id.* (emphases added). Yet again, the language "materially narrowed in other respects" relates for comparison back to the earlier recited language "[t]he asserted reissue claims

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are unmistakably broader in these respects." It follows that *Hester Indus.* also makes clear that a reissue claim will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter, contrary to the Examiner's belief.

There is a reason the Federal Circuit has repeatedly assessed recapture rule avoidance in terms of whether the reissue claims were materially narrowed in respects other than the broader aspects relating to surrendered subject matter. The reason involves the purpose served by permitting the recapture rule to be avoided under certain circumstances. This purpose is described in *Hester Indus.* as follows:

[T]his principle [i.e., avoidance of the recapture rule], in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

142 F.3d at 1482-83, 46 USPQ2d at 1649-50.

As explained in *Hester Indus.*, the recapture rule is avoided when two conditions are satisfied. First, an aspect of the invention must have been overlooked (e.g., not claimed) during patent prosecution. Second, the reissue claim must have been materially narrowed with respect to this overlooked aspect of the invention. Because recapture rule avoidance requires the reissue claim to be materially narrowed in an overlooked aspect of the invention, this material narrowing must be in respects other than the broader aspects relating to surrendered subject matter. Stated differently, we do not perceive how a material narrowing in an overlooked aspect would

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relate to surrendered subject matter since this subject matter, having been claimed and then surrendered during original prosecution, could not have been overlooked. Accordingly, the Examiner's belief (i.e., in order to avoid the recapture rule, reissue claims must be materially narrowing in aspects related to the surrendered subject matter) is incompatible with the purpose served by the recapture rule exception.

In addition, a careful study of their underlying facts reveals that the authorities cited by the Examiner do not in any way support his position.

In *Pannu*, the Federal Circuit stated that "[t]he narrowing aspect of the claim on reissue ... was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means [, and] [t]herefore, the reissued claims were not narrowed in any material respect compared to their broadening." 258 F.3d at 1372, 59 USPQ2d at 1600-01. If read in a vacuum, this statement might appear to support the Examiner's position. However, the court's opinion in general and this statement in particular must be read, not in a vacuum but, in light of the facts of the case on appeal.

The reissued claim in *Pannu* was narrowed by requiring the snag resistant means to be "at least three times greater" than the width of the haptics and by requiring the snag resistant means to be "substantially coplanar" with the haptics. 258 F.3d at 1372, 59 USPQ2d at 1600. As revealed in the underlying District Court decision, these same or similar limitations were present in claims throughout prosecution of the original patent application. *Pannu v. Storz Instruments, Inc.*, 106 F. Supp. 2d 1304, 1308 (S.D Fla. 2000). For this reason, the District Court held that the recapture rule had not been avoided because the narrowing limitations were

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not overlooked aspects of the invention and did not materially narrow the claim. *Id.*, 106 F. Supp 2d at 1308-09, citing for authority *Hester Indus.*, 142 F.3d at 1483, 45 USPQ2d at 1650 and *Clement*, 131 F.3d at 1469, 45 USPQ2d at 1165.

This factual background more fully illuminates the Federal Circuit's determination in *Pannu* that the reissued claims were not narrowed in any material respect compared with their broadening. This determination is not based on the fact that the narrowing limitations of the reissue claims were unrelated to their broadening. Rather, it is based on the fact that these same or similar limitations had been prosecuted in the original patent application and therefore were not overlooked aspects of the invention and did not materially narrow the reissue claims.

In contrast, as correctly explained by Appellants and not disputed by the Examiner, the narrowing limitations of the reissue claims on appeal are directed to aspects of the invention which had not been claimed and thus were overlooked during prosecution of the original patent application (Br. 4; Reply Br., filed July 24, 2003, 5). Additionally, since these limitations patentably distinguish over the prior art including the Brink patent applied during prosecution of both the original application (*see* Findings 2-6) and this reissue application (*see* Findings 10-13), the reissue claims must be considered materially narrowed (as both the Appellants and the Examiner have agreed). Finally, avoidance of the recapture rule is not prevented merely because Appellants' materially narrowing limitations are unrelated to the broadening aspects of the reissue claims. As previously indicated, it is well established that the recapture rule is avoided if the reissue claims were

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materially narrowed in respects other than the broader surrendered aspects.

*North American Container*, 415 F.3d at 1349, 75 USPQ2d at 1556; *Pannu*, 258 F.3d at 1371-72, 59 USPQ2d at 1600; *Hester Indus.*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50.

The other authorities cited by the Examiner also do not support his position.

*Anderson v. Int'l Eng'g & Mfg., Inc.* relates to the construction of a reexamination claim rather than avoidance of the recapture rule by a material narrowing of a reissue claim.

The reissue claims in *Clement*, like those on appeal here (e.g., *see* Findings 8 and 11), were both broader and narrower in aspects germane to a prior art rejection. 131 F.3d at 1470, 45 USPQ2d at 1165. However, the narrower limitation recited in the *Clement* reissue claims ("at least 59 ISO in the final pulp"; *see* clause (e) of reissue claim 49) also was recited in the patent claims (*see* clause (f) of patent claim 1). 131 F.3d at 1470, 1474, 45 USPQ2d at 1165, 1169. Therefore, the subject appeal is distinguishable from *Clement* because the narrowing limitation of *Clement*, like *Pannu*, was not overlooked during original prosecution and did not materially narrow the reissue claim.

Finally, *Mentor* also does not support the Examiner's belief that a reissue claim avoids the recapture rule only if its materially narrowing limitation is related to its broadening surrendered aspect. In *Mentor*, each of the limitations added to the reissue claims were thoroughly analyzed and determined to not be materially narrowing because the same or similar features were in the patent claims or the prior art. *Mentor*, 998 F.2d at 996,

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27 USPQ2d at 1525-26. It follows that the reissue claims of *Mentor*, like those of *Pannu* and *Clement*, failed to avoid the recapture rule because they had been broadened to include surrendered subject matter but had not been narrowed in any material respect.

In summary, the authorities cited by the Examiner do not support his belief that a reissue claim avoids the recapture rule only if its materially narrowing aspect is related to its broadening surrendered aspect. Indeed, the Examiner's view is not compatible with well established legal precedent as discussed above. Consistent with this precedent including the Examiner's cited authorities, the recapture rule is avoided if the reissue claim was materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention which were overlooked during prosecution of the original patent application and which patentably distinguish over the prior art.

### *Conclusions of Law*

Based on the record of this appeal, we hold that the reissue claims on appeal are broader than the patent claims in aspects relating to subject matter surrendered during original prosecution but that the recapture rule nevertheless is avoided because the reissue claims are materially narrowed in other respects.

*Remand*

We have made our above holding based on the limited record of this appeal. However, the broader record of the application includes a prior art reference which may evince that the appealed reissue claims (1) are unpatentable over the prior art and therefore (2) do not avoid recapture by a materially narrowing limitation.

Specifically, the application record includes US Patent 5,480,509 to Matsuo et al. (Matsuo)(Information Disclosure Statement, filed January 17, 2001). This patent was considered by the Examiner as indicated by citation initialing (id.), although the Examiner has never applied the Matsuo patent in a rejection of the reissue claims. Nevertheless, for the reasons detailed below, it appears that at least independent apparatus claim 36 and independent method claim 47 are unpatentable under 35 U.S.C. § 102(a) or § 103(a) over Matsuo.

Matsuo discloses a laminating apparatus comprising several embodiments (Figs. 1, 8, 11) that are characterized as improvements over a conventional prior art laminating apparatus (Figs. 17, 18). The respective disclosures concerning each of Matsuo's embodiments as well as the prior art laminating apparatus appear to expressly or inherently teach each and every limitation in claim 36. *See In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

For example, the claim 36 limitations of a lower outer shell portion with an upper outer shell portion manually movably connected thereto appear to be satisfied by Matsuo's Figure 11 embodiment which includes lower frame 1b and upper frame 1a since these frames are pivotally

connected such that the upper frame is inherently capable of manual movement between opened and closed positions (Figs. 11-12; col. 9, l. 28-col. 11, l. 63). Also, the cooperating pressure applying structures of claim 36 appear to be satisfied by the Figure 11 disclosure of cooperating pressure and heating rollers 10a, 10b (*id.*). Similarly, the previously discussed claim 36 limitations of lower and upper shell portions appear to be satisfied by the lower frame 100b and upper frame 100a of the prior art apparatus described by Matsuo since these frames are pivotally connected whereby the upper frame is inherently capable of manual movement between opened and closed positions (Figs. 17-18; col. 1, l. 22-col. 2, l. 59). The claim 36 limitations regarding cooperating pressure applying structures appear to be satisfied by the pressure and heat rollers 103a, 103b of this prior art apparatus (*id.*).

Concerning independent method claim 47, Matsuo does not expressly disclose manually engaging the upper frame of the Figs. 11-12 embodiment or the Figs. 17-18 prior art apparatus and lifting the upper frame to an opened position as required by the here claimed method. Significantly, Appellants' Specification also does not expressly disclose the manually engaging step of claim 47, and the May 16, 2001 Amendment of claim 47 which added this step does not assert that the Specification contains such express disclosure. Apparently, notwithstanding the lack of express disclosure, Appellants believe that an artisan would appreciate the upper outer shell portion is moved to an opened position by manual engagement, and likewise it seems appropriate to find that an artisan would appreciate the upper frame of Matsuo's Figs. 11-12 and 17-18 is moveable to an opened position by manual engagement notwithstanding the lack of express

disclosure. This finding is supported by the fact that Matsuo (like Appellants) does not disclose any non-manual mechanism for moving the upper frame to an opened position. For these reasons, as well as the reasons discussed previously with respect to claim 36, it appears that the Figs. 11-12 and 17-18 disclosures of Matsuo anticipatorily satisfy the limitations of method claim 47.

Alternatively, it appears that claim 47 is unpatentable under 35 U.S.C. § 103(a) over the aforementioned disclosures of Matsuo. Although Matsuo (like Appellants) does not expressly disclose opening the upper frame by manual engagement, Matsuo discloses manual operations for other aspects of Figs. 11-12 (col. 11, ll. 47-54) and Figs. 17-18 (col. 2, ll. 31-36). These disclosures of manual operations create an inference that the upper frame of Figs. 11-12 or Figs. 17-18 is moved to an opened position by manual engagement, and this inference is reinforced by the previously mentioned fact that the Matsuo reference contains no disclosure of a non-manual mechanism for moving the upper frame to an opened position. In this regard, we point out that an analysis under § 103 need not seek out precise teachings directed to the specific subject matter of the challenged claim, for it is appropriate to take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (Fed. Cir. 2007). Accordingly, in light of the inferences derived from Matsuo, it appears that one with ordinary skill in this art would have found it obvious to move the upper frame of Figs. 11-12 or Figs. 17-18 to the opened position by manual engagement as required by method claim 47.

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For the above-stated reasons, we remand this application so that the Examiner can address on the written record the issues of whether reissue claims 36-48 (1) are unpatentable over Matsuo and therefore (2) do not avoid recapture by a materially narrowing limitation. In addressing these issues, the Examiner must provide the written record with a detailed explanation of why Matsuo does or does not render unpatentable each of claims 36-48 under 35 U.S.C. § 102(a) (anticipation) or § 103(a) (obviousness) or § 251 (recapture).

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is **not** made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) does not apply.

*Order*

The decision of the Examiner rejecting claims 36-48 is reversed.

The application is remanded to the Examiner.

**REVERSED AND REMANDED**

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Pillsbury, Winthrop, Shaw, Pittman, LLP  
P. O. Box 10500  
McLean, VA 22102